

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

10/16/97

Hearing  
February 19, 1997

Paper No. 40  
CEW

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Fannie May Candy Shops, Inc.

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Serial No. 73/828,267

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Richard C. Browne, of Winston & Strawn for applicant.

Karen Leetzow, Trademark Examining Attorney, Law Office 101  
(Ronald Williams, Managing Attorney).

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Before Rice, Quinn and Walters, Administrative Trademark  
Judges.

Opinion by Walters, Administrative Trademark Judge:

Fannie May Candy Shops, Inc. has filed a trademark  
application to register the mark PIXIE for "ice cream."<sup>1</sup>

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<sup>1</sup> Serial No. 73/828,267, in International Class 30, filed September 29, 1989, based on use in commerce, alleging dates of first use and first use in commerce of July 10, 1989. Applicant also claims ownership of Registration No. 593,071, for the mark PIXIES, in stylized script, for "candy."

The Trademark Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark PIXIE PIE, previously registered for "prepared pies,"<sup>2</sup> that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Applicant and the Examining Attorney have filed briefs. Applicant's counsel and the Examining Attorney were present at the oral hearing before the Board. We affirm the refusal to register.

Two key considerations in the likelihood of confusion analysis in this case are the similarities between the marks and the similarities between the goods. We will consider, first, the marks. While our finding is based on a comparison of the marks in their entirety, we are guided, equally, by the well-established principle that, in articulating reasons for reaching a conclusion on the issue of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their

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<sup>2</sup> Registration No. 1,039,356, issued May 11, 1976, to Ice Master Corporation, in International Class 30. The registration has been renewed and Holly Ridge Foods, Inc. is the current owner of record. The registration includes a disclaimer of PIE apart from the mark as a whole.

entireties." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). We agree with the Examining Attorney's conclusion that PIXIE is the dominant portion of the registered mark PIXIE PIE. There is no evidence to indicate that PIXIE is other than completely arbitrary in connection with prepared pies, whereas PIE is merely the name of the goods identified in the registration and is likely to be so viewed in the mark PIXIE PIE. Applicant's mark, PIXIE, is identical to the arbitrary and dominant portion of registrant's mark and, as such, the overall commercial impressions of the two marks are substantially similar.

Turning our consideration to the goods, the Examining Attorney contends that because both applicant's and registrant's goods are broadly identified, registrant's prepared pies could include ice cream pies, which would encompass applicant's goods; that prepared pies and ice cream are both sold in grocery stores to the same class of purchasers, namely, the general public; that ice cream pies and ice cream are both sold in the frozen foods section of a grocery store; and that pies, whether made with ice cream or not, and ice cream are complementary dessert items, as pie is often served "a la mode," *i.e.*, topped with ice cream.

Applicant contends that the parties' goods travel in substantially different channels of trade, as applicant's

goods are sold only through its own specialty confectionery stores;<sup>3</sup> that applicant is the prior user and owner of a registration for the mark PIXIES for candy;<sup>4</sup> that applicant's mark PIXIES is famous in connection with candy; that, as applicant's prior PIXIES registration was not found by the PTO to be a bar under Section 2(d) to the registration of PIXIE PIE for prepared pies, so should the PIXIE PIE registration not bar registration of the mark herein;<sup>5</sup> that ice cream is a natural expansion of

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<sup>3</sup> Following denial of its request for reconsideration after final refusal, applicant submitted, in support of this contention, the affidavit of its Executive Vice President, John D. Thorne, stating that applicant's ice cream product is sold exclusively through its chain of confectionery stores and has never been sold elsewhere. This was followed two months later by a second affidavit of Mr. Thorne stating that applicant has no present intention to market or sell its ice cream product beyond the chain of confectionery stores in which such product is presently sold. Following the Examining Attorney's denial of this supplemental reconsideration request, and three days before filing its brief in this appeal, applicant submitted, also in support of this contention, the declaration and accompanying exhibits of its Chief Operating Officer, Michael W. Hennessy. Mr. Hennessy echoes Mr. Thorne's statements and adds that Fannie May retail outlets are "specialty confectionery boutiques" that sell only products made exclusively for its shops; that registrant's pies are not and never will be sold in Fannie May shops; that registrant's pies are sold only "through bakery departments of select grocery stores in the southeastern United States"; that the parties' goods are different; and that applicant's ice cream product is of "a super premium quality . . . which caters to a select and discriminating (sic) market of ice cream connoisseurs." Exhibits to this declaration include photographs of the exterior of a Fannie May shop and of the refrigerated display case in which applicant's ice cream is stored and displayed in a Fannie May shop. This evidence was considered by the Examining Attorney following a remand of this case for that purpose.

<sup>4</sup> Registration No. 593,071.

<sup>5</sup> In support of this contention applicant submitted a copy of the file of the cited registration. The prosecution history of the application from which this registration issued includes a refusal under Section 2(d) based on applicant's Registration No. 593,071 for the mark PIXIES for candy. The file history shows that the refusal was subsequently withdrawn.

applicant's specialty confectionery business; and that due to the differences in ingredients and methods of processing, the goods of the parties are in entirely different food categories. In addition to the previously noted evidence, applicant submitted, in support of its position, numerous form statements from consumers stating their opinion that "PIXIE as used on Fannie May ice cream is not likely to be confused with PIXIE PIE as used on frozen pies."<sup>6</sup>

It is well-established that when the marks at issue are the same or nearly so, the goods in question do not have to be identical to find that confusion is likely. As we stated in *In re Concordia International Forwarding Corp.*, 222 USPQ 352, 356 (TTAB 1983), ". . . the greater the degree of similarity in the marks, the lesser the degree of similarity that is required of the products or services on which they are being used in order to support a holding of likelihood of confusion." It is sufficient that the goods are related in some manner and that their character or the circumstances surrounding their marketing are such that they are likely to be encountered by the same people in situations that would give rise to the mistaken belief

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<sup>6</sup> These statements are of little or no persuasive value herein because the consumers have simply stated their opinions on the ultimate issue of likelihood of confusion. However, the Board is charged with the responsibility of determining this issue on the basis of its evaluation of the evidence. See, *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 919 (TTAB 1983).

that the producer was the same. *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Registrant's broadly worded identification of goods could reasonably include frozen and refrigerated pies which are either ready to eat or ready to bake. Thus, as noted by the Examining Attorney, the parties' goods overlap to the extent that registrant's goods as identified could include frozen, ready-to-eat pies made with ice cream. In all other respects, we find that the goods of the parties are related. Pies and ice cream are both dessert items. In fact, pie and ice cream are also complementary dessert items which may be served together. In this regard, we note the advertising copy in the file of the cited registration wherein registrant identifies "serving suggestions" for its pies, stating that its pies are "delicious with ice cream."

Applicant submitted evidence and argued that the goods of the parties are neither identical nor interchangeable; that they are made of different ingredients and by different methods; and that registrant's product requires preparation, whereas applicant's product is immediately consumable. We do not disagree with these facts; however, these distinctions between the parties' goods are not incorporated in the identifications of goods inasmuch as "prepared pies"

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could include frozen ice cream pies. Moreover, even if these distinctions were reflected in the identifications of goods, we are not convinced that these goods are not related when considered in the context of our analysis of likelihood of confusion.

Similarly, applicant's argument concerning the differences in the channels of trade are unpersuasive. While applicant extended the prosecution of this application with numerous supplemental filings after final action which seek, in large part, to distinguish the trade channels of the parties' goods, applicant ultimately declined to limit the trade channels in its identification of goods.<sup>7</sup> Thus, neither the application nor the cited registration contains limitations to the identification of goods. Rather, both identifications of goods are broadly worded. In this case, we must presume that the goods of the applicant and registrant are sold in all of the normal channels of trade to all of the normal purchasers for goods of the type identified. See *Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). That is, we must presume that the goods of applicant and registrant are sold through the same channels of trade to the same classes of purchasers. For example, prepared pies and ice cream are

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<sup>7</sup> We do not reach the question of how we would decide this appeal if a different identification of goods was before us. Our decision is necessarily limited to the facts of the case before us.

both sold through food stores to the general public. Thus, applicant's evidence of limitations on trade channels and the specific nature of goods sold in connection with either party's mark is not relevant to our determination of registrability herein.

Applicant's arguments with respect to its use and registration of PIXIES in connection with candy, as well as the fame of that mark, are, likewise, unavailing in this case. We do not have before us the question of the propriety of the issuance of the cited registration in view of applicant's prior registration, which would be properly addressed before the Board in a cancellation proceeding. Nor do we find persuasive the fact that registration of the cited mark was initially refused under Section 2(d) based on applicant's prior registration. As we have previously stated, each case must be decided on its own facts and, at a minimum, the goods in applicant's prior registration are different from the goods identified in this application. Further, we are not bound by the actions of the Examining Attorney in this or another application. *See, Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, at 1439 (TTAB 1993); and *Marmark Ltd. v. Nutrexpa S.A.*, 12 USPQ2d 1843, 1845 at Footnote 4 (TTAB 1989).



Therefore, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark, PIXIE, and registrant's mark, PIXIE PIE, their contemporaneous use on the closely related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

Decision: The refusal under Section 2(d) of the Act is affirmed.

J. E. Rice

T. J. Quinn

C. E. Walters  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board